



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,445	08/05/2003	Betty Birnbaum	1067-001	8287
26274 7590 11/29/2007 COWAN LIEBOWITZ & LATMAN P.C 1133 AVENUE OF THE AMERICAS 1133 AVENUE OF THE AMERICAS NEW YORK, NY 10036			EXAMINER GUIDOTTI, LAURA COLE	
			ART UNIT 3723	PAPER NUMBER
			MAIL DATE 11/29/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/634,445

**Applicant(s)**

BIRNBAUM, BETTY

**Examiner**

Laura C. Guidotti

**Art Unit**

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-29 is/are pending in the application.
- 4a) Of the above claim(s) 6-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3-5 and 23-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 March 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01 October 2007 has been entered.

### ***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "S-shape of said fingernail edge...*a valley...rounded peak*" (Claim 1) must be shown or the feature(s) canceled from the claim(s). For example, in Figure 2 "21A" refers to a peak of *an undulation* and "21B" refers to a valley of *an undulation*. A valley and rounded peak are only discussed and shown as being features of an undulation. It is noted though, that in Figure 1, reference numeral 16B corresponds to a rounded region (and not a "peak" or "valley"). In particular, the fingernail edge having a valley and a rounded peak must be shown. Also, the first rounded portion and second rounded portion of the rounded peak is not shown in the drawings. Further, the valley of the S-shape in a first undulation and a peak of the S-shape in a second undulation of opposite direction is also not shown in the drawings. A third undulation (Claim 26) is not shown in the drawings. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 3-5, and 23-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 Lines 14-20 incorporate subject matter that was not described in the specification or shown in the drawings at the time of the invention. Claim 1 recites that "said S-shape of said fingernail edge...from said straight edge to a *valley* and then proceeds outwardly...to a *rounded peak*, said rounded peak including a first rounded portion proceeding outwardly away from the further edge to a peak and a second rounded portion continuous with the first rounded portion..." However, the specification and drawings do not describe the S-shape edge as having a valley or a rounded peak including first and second rounded portions. The specification does describe *the undulations* as having peaks and valleys.

In addition, Claim 1 Lines 24-26 also incorporates subject matter not described in the specification or shown in the drawings at the time of the invention. This portion of Claim 1 recites that "said *valley of said S-shape* of the fingernail edge *is in* a first undulation and the *peak of said S-shape...is in* a second undulation of opposite direction to the first undulation and immediately following the first undulation. As the valley and peak of the S-shape of the fingernail edge is considered new matter as it is not described or shown, the particular location of undulations is also considered to be new matter. However, it is noted that these particular undulations with respect to their supposed portions of the S-shape of the fingernail edge are not described in the specification or shown in the drawings.

Further new claims 26-29 introduce subject matter not described in the specification or shown in the drawings at the time of the invention. The particular subject matter that is considered as new matter includes the location of a third undulation (at part of a fingernail edge from an end of a second rounded portion to a second end of a fingernail edge and immediately following the second undulation; only two full undulations are shown in Figure 3), a rounded edge at an end of a first *partial undulation* (and its location; only two full undulations are shown in Figure 3), and a second *partial undulation* (and its location; only two full undulations are shown in Figure 3).

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1, 3-5, and 23-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is particularly confusing in that it is unclear as to whether the peak and valley being referred to in Lines 14-20 is part of the "S-shape of said fingernail edge" or a portion of the undulations.

Claim 1 recites the limitations "the shape" and "the curvature" in Line 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 26 recites the limitations "the part" in Line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 26 recites the limitations "the end of said second rounded portion" in Line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 27 recites the limitations "the end of a first partial undulation" in Lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

Claim 28 recites the limitations "the end of a second partial undulation" in Lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

### ***Response to Arguments***

5. Applicant's arguments with respect to claims 1, 3-5, and 23-29 have been considered but are moot in view of the new ground(s) of rejection.

As stated above, the Examiner is confused as to the claimed structure of the S-shape of the fingernail edge. It appears that the terminology "valley" and "peak" have been attributed both to the S-shape of the fingernail edge when describing portions of the "S-shape" and to parts 21A and 21B of the undulation. This is particularly confusing. Also, after further review of the specification and drawings, the undulations shown in Figures 1-3 and 6 have varying locations with respect to the edges, and it is not clear in the Figures where the undulations are situated with respect to portions of the S-shape of the fingernail edge. And it is not particularly defined in the specification as to what is considered to be an entire (or partial) undulation. The Examiner requests further clarification of the claimed invention.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Laura C. Guidotti whose telephone number is (571) 272-

1272. The examiner can normally be reached on Monday-Thursday, 7:30am - 5pm, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on (571) 272-4485. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Laura C Guidotti/  
Patent Examiner  
Art Unit 3723

lcg